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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,040	11/29/2000	Toshikatsu Furunaga	Q62004	8611

7590 05/24/2002

SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

RAJGURU, UMAKANT K

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 05/24/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

T-D-7

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on Jan 23, 2002 (paper no 6)
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-19 is/are pending in the application.
- Of the above claim(s) 17-19 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-16 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ ☐ Interview Summary, PTO-413
- ☒ Notice of References Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other _____

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DETAILED ACTION

1. An amendment (paper no. 6) has been filed on January 23, 2002.
2. Claims 1-16 are under examination.
3. Applicants' affirmation of election of claims 1-16 is noted.
4. Rejection of claims 13-16 under 35 USC 112, second paragraph (see item 4 in prior office action, paper no. 5) is now withdrawn following appropriate amendments of said claims.

Also withdrawn is the rejection of claims 1-16 under 35 USC 103(a) (see item 6 of same office action) because of applicants' arguments against said rejection. Arguments are persuasive.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 9 and 11, are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshimura et al (USP 6171381).

Yoshimura describes an aqueous metallic ink composition comprising a metallic powder pigment, a colorant, water, a water-soluble organic solvent, a natural polysaccharide and a water-soluble soy polysaccharide or water-soluble polysaccharide derivatives (col. 1, lines 3-10). Patentee discloses in col. 2, ^{lines} 23-27, that the polysaccharide functions as a coating or size for a substrate such as paper. Preparation of polysaccharide is described in col. 6, line 60 to col. 7, line

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59 and the available polysaccharides disclosed in col 7 lines 40-42 are mentioned in instant

specification. Surfactant is mentioned in col 11, line 66.

Claims 1, and 2^{9&11} therefore lack novelty.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10119425⁹ in view of Yoshimura et al (USP 617381).

(JP' 425 has been earlier cited in office action).

Disclosure of JP' 425 is summarized in office action paper no. 5 item 6). That of Yoshimura is summarized above.

JP'425 does not mention (claimed) polysaccharide as a suitable water-soluble polymer of the composition.

It would have been obvious to add to the composition of JP '425, the polysaccharide of Yoshimura with the expectation of (a) improving resistance of the composition (as a size) to water (b) to maintain the density of color by minimizing penetration of colorant particles into substrate such as paper and © to enhance stability of viscosity. It would also have been obvious to add surfactant for improving wetting.

It is noted that prior art fails to disclose that⁽ⁱ⁾ the surface active agent is nonionic having HLB of 5-15 (instant clams 11, 12) and (ii) ratio by wt of cationic polymer to polysaccharide as from 0 to 50 (instant claims 13-16). It is the examiner's position, in this respect, that selection of

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a surfactant with claimed limitations and also choice of specific amounts of cationic polymer and polysaccharides are within the expertise of one of ordinary skill in the art who will do that to ensure enhanced dispersion and wetting.

9. Claims 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims are vague in containing "HBL" which as an abbreviation. Abbreviations are not to be included in claims, unless they are spelled out earlier in the specification and/or claim.

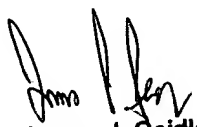
Any inquiry concerning this communication or earlier communications from the examiner should be directed to U.K. Rajguru whose telephone number is 703-3078-3224. The examiner can normally be reached on Monday-Friday from 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck, can be reached on (703) 308-2462. The fax phone number for the organization where this application or proceeding is assigned is 872-9310/9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-0661.


UKRajguru:evh

5/14/02


James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700